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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,752	06/23/2003	Alan H. Grant	P68705US0	5704

136 7590 11/20/2003

JACOBSON HOLMAN PLLC  
400 SEVENTH STREET N.W.  
SUITE 600  
WASHINGTON, DC 20004

EXAMINER

STULTZ, JESSICA T

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

ABW

# Office Action Summary

Application No.

10/600,752

Examiner

Jessica T Stultz

Applicant(s)

GRANT, ALAN H.

Art Unit

2873

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 11-21 is/are rejected.
- 7) ☒ Claim(s) 5-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to for minor informalities. The proposed drawing changes are described in the attached form number 948. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 12, and 21 (and therefore dependent claims 3, 13-20) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "high transmission" in claims 2, 12, and 21 is a relative term, which renders the claim indefinite. The term "high transmission" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Specifically, it is unclear as to what the term "high" defines as a limitation in the claims. It is assumed that this phrase means "transmission greater than about 60 percent" based on the transmission shown in Figures 3 and 4 (this being the assumed meaning for purposes of examination). Further clarification is needed.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al.

Regarding claim 1, Suzuki et al discloses eyewear for improved visual clarity (Column 1, lines 6-10 and Column 3, lines 33-42, wherein the lenses are changed to improve photochromic properties and therefore improve visual clarity) comprising: an eyeglass frame having rims to hold two lenses (Column 1, lines 6-10 and 35-40, wherein the lenses are eyeglass lenses and are therefore held in an eyeglass frame); a first lens fitted within the frame and having a green tint (Column 1, lines 35-40 and Column 3, lines 33-42, and Table 1, wherein example 1 is a lens with a green tint and a yellowish green tint and therefore one of the lens has a green tint); and a second lens fitted within the frame and having yellow tint (Column 1, lines 35-40 and Column 3, lines 33-42, and Table 1, wherein example 1 is a lens with a green tint and a yellowish green tint and therefore the other lens has a yellow tint).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al.

Regarding claim 11, Suzuki et al discloses eyewear as shown above, and it is obvious that the eyewear comprises at least one lens including a prescription vision correction, since it is well known in the art of eyeglass lenses with photochromic properties and functional properties to have prescription vision correction for the purpose of protection of the patient's eyes during

vision correction. Therefore it would have been obvious for the eyewear of Suzuki et al to further comprise at least one lens including a prescription vision correction, since it is well know in the art of eyeglass lenses with photochromic properties and functional properties to have prescription vision correction for the purpose of protection of the patient's eyes during vision correction.

Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable Suzuki et al and further in view of Hoffman.

Regarding claims 2 and 4, Suzuki discloses and teach of eyewear as shown above in claim 1, but does not specifically disclose that the green tinted lens has a transmission greater than about 60 percent beginning around 470 nm, and a band pass between 450-520 nm, and that the yellow tinted lens has a transmission greater than about 60 percent beginning around 500 nm, and a band pass between 510-600nm. Hoffman teaches of tinted lenses wherein pale green tinted lenses have transmission beginning at about 470 nm, specifically at 490 nm, and a band pass between 450-520 nm (Column 12, lines 35-55) for the purpose of providing better contrast and better overall viewing characteristics (Column 12, lines 42-55) and yellow tinted lenses having transmission starting at 500 nm and a band pass between 520-600 nm (Column 10, lines 58-63) for the purpose of providing enhanced contrast in outdoor light environments (Column 11, line 10, line 66-Column 11, line 11). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the tinted lenses of Suzuki et al to include the green tinted lens having a transmission greater than about 60 percent around 470 nm and the yellow tinted lens having a transmission greater than about 60 percent beginning around 500 nm since Hoffman teaches of tinted lenses wherein pale green tinted lenses have transmission beginning at about 470 nm, specifically at 490 nm, and a band pass between 450-520 nm for the

purpose of providing better contrast and better overall viewing characteristics and yellow tinted lenses having transmission starting at 500 nm and a band pass between 520-600 nm for the purpose of providing enhanced contrast in outdoor light environments.

Claims 12, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al in view of Hoffman.

Regarding claims 12 and 19, Suzuki et al discloses eyewear for improved visual clarity (Column 1, lines 6-10, Column 1, lines 6-10 and Column 3, lines 33-42, wherein the lenses are changed to improve photochromic properties and therefore improve visual clarity) comprising: a first lens having a green tint and a second lens having a yellow tint (Example 1, Table 1, wherein one lens would have some yellow tint and the other lens would have some green tint), wherein the first and second lenses are worn simultaneously for improved visual clarity (Column 3, lines 33-42), but does not specifically disclose that the green tinted lens is pale green and has a transmission greater than about 60 percent beginning around 470 nm and that the yellow tinted lens has a transmission greater than about 60 percent beginning around 500 nm. Hoffman teaches of tinted lenses wherein yellow tinted lenses have transmission starting at 500 nm (Column 10, lines 58-63) for the purpose of providing enhance contrast to outdoor light environments (Column 11, line 10, line 66-Column 11, line 11) and pale green tinted lenses have transmission beginning at about 470 nm, specifically at 490 nm (Column 12, lines 35-44) for the purpose of providing better contrast and better overall viewing characteristics (Column 12, lines 42-55). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for one of the lenses of Suzuki et al to include the green tinted lens having a transmission greater than about 60 percent around 470 nm and the yellow tinted lens having a

transmission greater than about 60 percent beginning around 500 nm since Hoffman teaches of tinted lenses wherein yellow tinted lenses have transmission starting at 500 nm for the purpose of providing enhance contrast to outdoor light environments and green tinted lenses have transmission beginning at about 470 nm , specifically at 490 nm, for the purpose of providing better contrast and better overall viewing characteristics.

Regarding claim 18, Suzuki et al and Hoffman disclose and teach of the eyewear as disclosed above in claim 12 and Suzuki et al further discloses that the eyewear comprises at least one lens including a prescription vision correction (Column 1, lines 6-10, wherein the eyeglass lenses include “functional properties” which would include prescription vision correction).

Regarding claim 20, Suzuki et al and Hoffman disclose and teach of the eyewear as disclosed above in claim 12, Hoffman further teaches that the lenses are contact lenses (Column 10, lines 33-63 and Column 12, lines 27-55) for the purpose of altering the light transmittance characteristics of the lens over the visible light range (Column 3, lines 19-26). Therefore it would have been obvious to one having ordinary skill in the art for the lenses of Suzuki et al to be contact lenses since Hoffman further teaches that the lenses are contact lenses for the purpose of altering the light transmittance characteristics of the lens over the visible light range.

***Allowable Subject Matter***

Claim 21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 3 and 13-17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 5-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103.

Specifically in reference to claims 3, 5-6, 8-10, and 13-17 and independent claim 21, none of the prior art either alone or in combination disclose or teach of eyewear as disclosed above, specifically wherein the color saturation level of the green tinted lens filter is less than the color saturation of the yellow filter.

Specifically in reference to claim 7, none of the prior art either alone or in combination disclose or teach of eyewear as disclosed specifically wherein the green tinted lens has a peak filter bandwidth of 500 nm and the yellow tinted lens has a peak filter bandwidth of 555nm.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chandler, Bawa, Betz et al, and Mueller et al are cited as being some similar structure to the claimed invention.

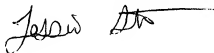
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T Stultz whose telephone number is (703) 305-6106. The examiner can normally be reached on M-F 8-4:30.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 703-308-4883. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Jessica Stultz  
Patent Examiner  
AU 2873  
November 13, 2003



JORDAN SCHWARTZ  
PRIMARY EXAMINER